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10/044,260	01/11/2002	David Emery Virag	PU 020010	7877

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EXAMINER

CHAN, WING F

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.
10/044,260

Applicant(s)

Virag et al

Examiner

Wing Fu Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on May 6, 2003

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

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1. This Office action is responsive to the amendment filed 5/6/03. As directed by the amendment, claim 10 was amended.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7, 10-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is inadequately written to provide support for “a priority rating of entries in the database application” as is claimed in claim 7. The specification (page 12 lines 22-25) only disclose a priority listing of business based on paid additional amount of money which is different from claim 7.

The specification is inadequately written to provide support for claims 10-13 in that the specification discloses two separate embodiments the first being the directory assistance embodiment and the second being a voice mail embodiment (see page 10 lines 12-32). There is no single integrated embodiment which discloses directory assistance and voice mail together, therefore the specification is inadequately written to provide support for claims 10-13.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 8, 9, 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerszberg et al (US PAT. NO. 5,949,474 hereinafter Gerszberg).

Gerszberg discloses a telecommunication method and system comprising a telecommunication device (e.g. figure 3A) having a display for viewing textual information, the device connected to a DSL telephone network (e.g. col. 3 line 52, col. 5 lines 16-17), a database application which includes directory information (e.g. col. 5 lines 51-64), a mechanism (e.g. fig. 3A, buttons 165) coupled to the telecommunication device to provide the user with access when the mechanism is activated to provide directory information to the display of the telecommunication device in response to user entered text information. Note entire patent.

6. Claims 1-5, 8, 9, 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gerszberg et al (US PAT. NO. 6,292,210 filed 12/31/97 hereinafter Gerszberg '210).

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Gerszberg '210 discloses a telecommunication method and system comprising a telecommunication device (e.g. figure 3A) having a display for viewing textual information, the device connected to a DSL telephone network (e.g. col. 4 line 63-64, col. 6 lines 26-27), a database application which includes directory information (e.g. col. 6 line 64 to col. 7 line 7), a mechanism (e.g. fig. 3A, buttons 165) coupled to the telecommunication device to provide the user with access when the mechanism is activated to provide directory information to the display of the telecommunication device in response to user entered text information. Note entire patent.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (for example) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 6, 7, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg or Gerszberg '210 in view of Desmond et al (US PAT. NO. 6,269,337 filed 7/1998 hereinafter Desmond).

Regarding claims 6, 20, both Gerszberg and Gerszberg '210 differs from the claimed invention in not disclosing the directory information includes business hours of an entry. However, it is notoriously old and well known in the art that a user of directory assistance services often wants to know additional information such as business hours, etc. (e.g. see Desmond col. 1 lines 33-38), and Desmond teaches a directory service which also provides the user with additional information associated with the entry such as business hours. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg or Gerszberg '210 to provide additional information associated with the entry such as business hours to satisfy the needs of the user.

Regarding claims 7, 21, Desmond teaches that the listed (entry) party is charged a fee for this additional information service (e.g. col. 2 lines 15-20), this obviously is a preference criteria as claimed.

9. Claims 7, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg or Gerszberg '210 in view of Rondeau (US PAT. NO. 5,850,433).

Regarding claims 7, 21, both Gerszberg and Gerszberg '210 differs from the claimed invention in not disclosing the directory information is based on a preference criteria. However, it

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is notoriously old and well known in the art to provide directory information based on a user profile (e.g. preference criteria), for example see Rondeau's abstract. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg or Gerszberg '210 to provide directory information based on user profile (e.g. preference criteria) to improve and customize service to the user.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gerszberg et al (US PAT. NO. 6,052,439) discloses a network server platform telephone directory white-yellow page services.

11. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 for any facsimile communications (for Technology Center 2600 only).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is (703) 305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


WING F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC